

REMARKS/ARGUMENTS

I. STATUS OF CLAIMS

Claims 1-4, 14, and 16-36 remain in this application.

II. ELECTION/RESTRICTIONS

The Office Action has withdrawn Claims 30-31 pursuant to 37CFR 1.142(b). The Office Action also states that election was made without traverse in the reply filed on 2/23/07. Applicant objects to the withdrawal of the claims as Claims 30-31 are dependent claims and depend upon Claim 1. Further, the election made in the reply filed on 2/23/07 did not concern Claims 30-31 because said claims were added in the reply filed on 8/8/07 **after** the election was made on 2/23/07 in response to the restriction requirement of 1/18/07. The restriction requirement of 1/18/07 stated that invention I encompassed Claims 1-3, 14, 16, and 18, and invention II encompassed Claims 4, 17, and 19-29. Neither invention I nor invention II included Claims 30-31. Therefore, no election was made in the reply filed on 2/23/07 with respect to Claims 30-31. Claims 30-31 cannot be withdrawn based on the Office Action's statement.

III. CLAIM REJECTIONS – 35 U.S.C. § 102

The Office Action rejects Claims 1-3, 14, 16, 18 and 32-36 under 35 U.S.C. § 102(e) as being anticipated by Zigmond et al. (6,698,020). The rejection is respectfully traversed.

Claim 1:

Claim 1 appears as follows:

1. A process for enhancing viewership of television advertisements, comprising:
  - designating a beginning portion of a commercial break in a program segment;
  - wherein the beginning portion is of a particular length of time;
  - wherein the beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break before the viewer causes a digital video recorder (DVR) to skip through the commercial break; and
  - pausing playing of the program segment, by the DVR, after displaying the teaser.

Applicant would like to point out that the Office Action has overlooked aspects of Zigmond that are key to analyzing Zigmond. Zigmond performs the following:

- 1) Zigmond interrupts display of the video feed (col. 15, lines 57-65).
- 2) Zigmond then displays an advertisement from the advertisement repository (col. 7, lines 26-36, col. 15, lines 57-65).
- 3) After the advertisement is displayed, Zigmond displays the video feed (col. 4, lines 36-52). Note that the video feed was progressing in real time as Zigmond displayed his advertisement. This means that at the point in time when Zigmond redisplay the video feed, the video shown can be in any state, e.g., in the middle of displaying an advertisement or already in the program material.

This is quite different than what is cited in Claim 1. The differences that Claim 1 cites are:

- 1) The cited commercial break is the original commercial break **in the program segment**, not a replacement as taught by Zigmond.
- 2) The program segment is paused **after** the teaser (the teaser is part of the commercial break **in the program segment**) is displayed.

The Office Action has not considered Claim 1 as it is actually worded. The Office Action has ignored that Claim 1 cites that the designation of the beginning portion of a commercial break is **in a program segment** and that the beginning portion is of a particular length of time. The Office Action in the Response to Arguments section cites this passage of Claim 1 and characterizes Zigmond as (emphasis added):

“Further, as Zigmond discloses wherein the beginning portion of the commercial break will consist of a menu indicating a plurality of advertisements to be selected (column 16, line 65-column 17, line 9), **he clearly discloses designating a beginning portion of a commercial break.**”

Zigmond in col. 16, line 65-col. 17, line 9 is describing what happens **after** the video feed has been interrupted. Zigmond states in col. 16, line 67-col. 17, line 3: “Each of the two or more selected advertisements is displayed at the appropriate time using a split-screen or another arrangement by which the viewer may see both advertisements.” It is clear that Zigmond is talking about his ad insertion device displaying its own formatted set of advertisements and not advertisements in the original video feed.

Therefore, it is clear that the Office Action has not considered the actual wording of Claim 1. Claim 1 specifically cites (emphasis added) “designating a beginning portion of a commercial break **in a program segment**” and “wherein the beginning portion is of a particular length of time”. The Office Action has confused Zigmond’s display of advertisements **after** the interruption of the video feed with Claim 1’s citation of a commercial break **in a program segment**.

The Office Action’s statement in the Response to Arguments section with regard to designating a commercial break within a program is confusing and technically incorrect. The Office Action states:

“In response, Zigmond discloses pausing the program to *insert* a commercial break *into* the displayed video program (column 16, lines 30-44). Zigmond designates where the commercial break should occur and then inserts the

required advertising. Thus, applicant's arguments are not persuasive, as Zigmond is *designating* the commercial break *within* the program."

However, this analysis of Zigmond is technically incorrect. Zigmond interrupts displaying the **original** video feed. This means that anything Zigmond does while interrupting the **original** video feed is not part of the **original** video feed and therefore is not part of the program segment as cited in Claim 1. Further, the office Action's statement that "Zigmond discloses pausing the program to *insert* a commercial break *into* the displayed video program" is technically incorrect. Zigmond has interrupted the video feed in order to display his advertisement on the TV screen. No insertion is performed in the original video feed, but rather an advertisement is displayed on the TV. Zigmond specifically states that he continues displaying the video feed **after** the advertisement was displayed. Zigmond **cannot** disclose that he has inserted a commercial break into the original video feed and therefore could **not** disclose designating a beginning portion of a commercial break **in a program segment** as cited in Claim 1.

The Office Action demonstrates that it has not considered the actual wording of Claim 1 through its focus on the "displayed video program" which has nothing to do with the claim as it is worded.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Further, Zigmond does not teach or disclose **pausing** playing of the program segment, by the DVR, **after displaying the teaser** as cited in Claim 1. As discussed above, the teaser is part of the program segment. Zigmond's advertisements are clearly **not** part of the original video feed. Zigmond clearly states that he displays his

advertisement **after** he interrupts the video feed. Once again, the Office Action has not considered the actual wording of Claim 1.

In a proper rejection under § 102(e) the cited reference must show each and every claimed feature in the same combination as arranged in the claim. See Lewmar Marine, Inc. v. Bariant, Inc., 827 F.2d 744, 747-48, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987). If even a single element or limitation is missing from the reference, anticipation is not found. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Zigmond therefore does not teach every aspect of the claimed invention either explicitly or impliedly.

Claims 1 and 32 are allowable. Claims 2-3, 14, and 18 are dependent upon Claim 1 and are allowable. Claims 30-31 are dependent upon Claim 1. New Claims 33-36 are dependent upon Claim 32 and are allowable. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 102(e).

Claim 16:

Claim 16 appears as follows:

16. A process for enhancing viewership of television advertisements, comprising:
  - designating a beginning portion of a commercial break in a program segment;
  - wherein the beginning portion is of a particular length of time;
  - wherein the beginning portion is authored to cause a DVR to display a menu to a viewer;
  - pausing playback of the program segment, by the DVR, while displaying the menu; and
  - wherein the viewer is allowed to skip past the menu and continue viewing the program segment, thereby causing the DVR to unpause the playback of the program segment, or to select a particular item via the menu.

As discussed above, Zigmond does not teach or disclose a system that designates a beginning portion of a commercial break **in a program segment**, and wherein the beginning portion is of a particular length of time as cited in Claim 16. Zigmond does not contemplate such a feature. The Office Action has not considered the actual wording of Claim 16. The Office Action clearly demonstrates this by stating in the Response to Arguments section:

“As Zigmond’s system defines and creates the commercial break, he clearly meets the claims limitations.”

This is clearly a misinterpretation of the actual wording of Claim 16. Claim 16 clearly cites that the beginning portion of the commercial break is **in the program segment**. The Office Action supports that Zigmond does not teach or disclose such a feature by stating that Zigmond “defines and creates the commercial break”. Therefore, Zigmond’s commercial break is **not** in Zigmond’s original video feed and therefore **cannot** be considered to be in the program segment as Claim 16 cites.

Further, since Zigmond does not contemplate designating a beginning portion of a commercial break in a program segment, Zigmond does not disclose wherein the beginning portion is authored to cause a DVR to display a menu to a viewer as cited in Claim 16. As discussed above, Zigmond in col. 16, line 65-col. 17, line 9 is describing what happens **after** the video feed has been interrupted. Zigmond states in col. 16, line 67-col. 17, line 3: “Each of the two or more selected advertisements is displayed at the appropriate time using a split-screen or another arrangement by which the viewer may see both advertisements.” It is clear that Zigmond is talking about his ad insertion device displaying its own formatted set of advertisements and not advertisements in the original video feed. Therefore, Zigmond does not contemplate wherein the beginning portion is authored to cause a DVR to display a menu to a viewer as cited in Claim 16.

In a proper rejection under § 102(e) the cited reference must show each and every claimed feature in the same combination as arranged in the claim. See Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747-48, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987). If even a single element or limitation is missing from the reference, anticipation is not found. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Zigmond therefore does not teach every aspect of the claimed invention either explicitly or impliedly.

Claim 16 is allowable. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 102(e).

#### IV. MISCELLANEOUS

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Applicant believes that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.

The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. § 1.136.

The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: February 5, 2008

/KirkDWong#43284/

Kirk D. Wong

Reg. No. 43,284

2055 Gateway Place, Suite 550  
San Jose, California 95110-1089  
Telephone No.: (408) 414-1080 ext. 214  
Facsimile No.: (408) 414-1076